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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/759,993	01/16/2004	Toshiaki Noguchi	17371	8686
23389 7590 08/21/2008 SCULLY SCOTT MURPHY & PRESSER, PC 400 GARDEN CITY PLAZA SUITE 300 GARDEN CITY, NY 11530				
EXAMINER				
NGUYEN, THUY-VI THI				
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3689				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/759,993

Applicant(s)

NOGUCHI ET AL.

Examiner

THUY VI NGUYEN

Art Unit

3689

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SE/US)
Paper No(s)/Mail Date 01/16/04; 03/15/04
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is in response to applicant's communication on January 16, 2004 wherein claims 1-20 are currently pending.

Information Disclosure Statement

2. The information disclosure statements (IDS) submitted on 01/16/2004 and 03/15/2004 have been considered. Initialed copies of the 1449 Forms are enclosed herewith.

Priority

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The independent claims 1 and 13 recited "*input section* , *specifying section* , *order generating section* , *securing section* , *dispatching section* , *recovering section*" and all the " means" in claims 19, and 20 are unclear. Therefore, it is interpreted as software having all the sections for inputting and

generating information regarding to rental equipment. As for claims 1 and 7, step (d) "*securing step (or section) of securing the medical equipment...*" and the step (f) "*a reprocessing step (or section) of recovering the medical equipment*" are unclear. Therefore, step (d) is interpreted as "*securing equipment required/or acquiring equipment/or checking the equipment is available in accordance with an order*", step (f) is interpreted as "*a reprocessing step of recovering/updating the equipment after rental has terminated/ or returned*".

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-6, 13-18, 19-20 are rejected under 35 U.S.C. 101 because the claims deal with a system containing software and do not meet any of the statutory items such as process (method), machine (apparatus), manufacture (product) or composition. The system claims appear to be an apparatus claim in a preamble "*a medical equipment rental system comprising*", however, there are no normal structures or functional element which are required in an apparatus claim. For instant, the independent claims 1 and 13 recited "*input section, specifying section, order generating section, securing section, dispatching section, recovering section*" are appear to be software. The independent claims 19 and 20 recited "*input means for inputting, means for specifying, means for generating, means for securing, means for dispatching, and means for*

recovering" are also appear to be software. Therefore, the claims are directed to nonstatutory subject matter.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 7-12, 1-6, 13-18, 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over NAKAO et al (US 2003/0098022) in view of ROYER ET AL (US 2005/0187833) or vice versa.

As for independent method claim 7, NAKAO et al fairly discloses a similar medical equipment rental method comprising the steps of:

{see Fig. 1; par. 0054; 0055]

(a) inputting step of inputting a category of a medical examination based on the basis of diagnosis results;

{see par. [0006 " ... *inputting the treatment records and various data of the patient*), par. [0014 ...*inputting data such as measurement result*], par. [0076 "...*operation input section (302) and (703)*, figures 6, 8 and 19)];

(b) specifying step of specifying an examination date and time for the medical examination [see par. 0113 and figure 14 "...*measurement/or examination date*

information"; (see par. 0151 and figure 19 "...date of using the medical"); (par. 0152 and figure 20 "... date of giving treatment")]

c) generating step of generating an order for rental of medical equipment required in the medical examination;

{this is inherently included in the rental processing of NAKAO et al in order to obtain/rent the medical equipment. For example: *a renting processing section for performing processes related to renting of medical equipment* (par. 0079; figure 7 (element 507); *and receiving a request for renting a medical equipment* (figure 22,. Step 401)).

NAKAO et al fairly teaches the claimed invention except for explicitly disclosing a rental service method having "securing the medical equipment required in accordance with a order generated; dispatching step of dispatching the medical equipment; reprocessing step of recovering the medical equipment after rental". Note that on pars. [0182] and [0185], NAKAO et al discloses that the renting process is not limited to the nebulizer or medical equipment alone, In other word, the renting process can be applied to other equipment as well and this is within the scope of the invention.

In a similar method for renting equipment, ROYER ET AL discloses well known steps for managing an equipment rental business including automated equipment rental management and reservation system comprising the steps of:

(d) securing equipment required/or acquiring equipment/or checking the equipment is available in accordance with an order [...i.e. *tracking the movement and status of the rental equipment; and confirm the availability of equipment for every*

reservation; par. 0001; par. 0011-0012 and par. 0056 and figure 3 (*equipment available at cite*));

(e) dispatching step of dispatching the equipment secured in the equipment securing step [...*dispatched the equipment form one place to another*; abstract; par. 0072; 0073 figure 5 (Dispatch 196)]; and

(f) a reprocessing step of recovering the equipment after rental has terminated/ or returned.

{see par. 0038 which teaches the recovering and updating of the returned equipment inventory after returning; par. 0063 and figure 4 (inventory list 114).

Note that on par. [0013]-[0014], ROYER ET AL discloses that the system updates automatically and regularly and provide the benefit that user will be able to view the status of each piece of equipment of a specified category at a particular location and determine whether any of the equipment is available for rental. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of NAKAO et al by including the well known equipment rental managing steps (d), (e) and (f) of ROYER ET AL cited above to obtain one of the benefit cited above.

Alternatively, the teachings of ROYER ET AL is cited above. ROYER ET AL fails to deal with equipment related to medical equipment and the steps for selecting the appropriate medical equipment such as steps (a)-(c) above. These steps are taught in NAKAO et al above. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of ROYER ET AL by including the steps of

identifying the medical equipment as taught by NAKAO et al as mere applying to other rental equipment as mentioned by NAKAO et al in par. [0182] and [0185].

As for claim 8, Royer/Nakao discloses

a reservation information generating step of generating reservation information including date and time information specified in the examination date and time specifying step {see ROYER et al, par. [0007][...*specified date and type of equipment*], fig. 3]

As for claim 9, Royer/Nakao discloses wherein the medical equipment securing step comprises:

a reservation information receiving step receiving the reservation information generated in the reservation information generating step [figures 5 -6; par. 0072-0073];

a reservation judging step of judging whether or not the required medical equipment can be secured at the date and time specified in the examination date and time specifying step { see ROYER et al. par. 0037 *reservation information can be changed to display* ; par. 0065 and figures 5-7 " *changes element (140)*} and

a reservation acceptance information generating step of generating information indicating that acceptance of a reservation has been completed { see ROYER et al. par. 0055; "*the status (46) can be changed to "YES" if the reservation for equipment are covered and scheduled complete*"}.

As for claim 10, Nakao/Royer discloses referring to an examination category correspondence table which associates categories of medical examination with types of

medical equipment [See NAKAO figures 14 and 19 for the category of medical examination].

As for claim 11, Nakao/Royer discloses referring to an examination category correspondence table which associates categories of medical examination with types of medical equipment [See NAKAO figures 14 and 19 for the category of medical examination].

As for claim 12, Nakao/Royer referring to an examination category correspondence table which associates categories of medical examination with types of medical equipment [See NAKAO figures 14 and 19 for the category of medical examination].

As for independent system claim 1, which is different only from independent method claim 7 in the substitution of the "step for" for "section for", the system of NAKAO et al /ROYER ET AL includes the "section for" for carrying out the "steps for" as indicated in Figs. 1-3. Alternatively, the substitution of "section for" for "steps for" would have been obvious as mere substitution of similar or equivalent terms. There fore, it is rejected for the same reasons set for the rejection of independent claim 7 above.

As for claim 2, Royer /Nakao disclose wherein the rental order generating section of the rentee system comprises:

a reservation information generating section for generating reservation information including the date and time information specified by the examination date and time specifying section and information about the medical equipment required in the medical examination [...see Royer; figures 5-6]; and

a reservation information transmission section for transmitting the reservation information generated by the reservation information generating section, to the rental service system [see Royer, figures 5-6 "dispatch 196"].

Note: claim 2 is directed toward a system which containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. See MPEP 2114 and Ex parte Masham, 2 USPQ2d 1647 (1987).

As for claim 3, which has the same limitation as claim 9 above, it is rejected for the same reasons set forth in the rejection of claim 9 above.

As for claims 5 and 6, which deals with the types of examination category stored in a data base for identifying the types of medical equipment needed, i.e. use of a correspondent table, this appears to be taught in Figs. 14 and 19, wherein table format are used to identify the desired rental equipment, and Nakao; figures 1, 6, 7 and par. 0022, 0076, 0079 **for memory section** (304 and 505) which discloses an examination category correspondence storing section for storing an examination category correspondence table which associates categories of medical examination with types of medical equipment [see the medical equipment required in accordance with the order generated by the rental order generating section being secured by referring to this examination category correspondence table (this is inherently included in the rental processing of NAKAO et al in order to obtain/rent the medical equipment.

Moreover, these are merely data stored in a database and they appear to be non-functional descriptive material and have no patentable weight.

Note: claims 5 and 6 are directed toward a system which containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. See MPEP 2114 and Ex parte Masham, 2 USPQ2d 1647 (1987).

As for claim 4, which has the same limitation as in dep. claim 5 or 6 above, it's rejected for the same reason set forth in the rejection of dep. claim 5 or 6 above.

As for **independent system claims 13 and 20**, which include the term "endoscope equipment" instead of "medical equipment" in the preamble and in the body of the claims, the term "endoscope" is merely the type or function of the medical equipment, this has no patentable weight in an apparatus claim since in apparatus claim, only structures matter and there is no structural differences. Moreover, NAKAO et al discloses on pars. [0182] and [0185] that other medical equipment can be utilized. More over, the system claims 13 and 20 which are different only from independent method claim 7 in the substitution of the "step for" for "means for", the system of NAKAO et al /ROYER ET AL includes the "mean for" for carrying out the "steps for" as indicated in Figs. 1-3. Alternatively, the substitution of "means for" for "steps for" would have been obvious as mere substitution of similar or equivalent terms. There fore, they are rejected for the same reasons set for the rejection of independent **claim 7 above**.

As for claim 14, which has the same limitation as claim 2 above, it is rejected as the same reason set forth the rejection of claim 2 above.

As for claim 15, which has the same limitation as claim 9 above, it is rejected as the same reason set forth the rejection of claim 9 above.

As for claim 16-18, which as the same limitations as 4-6 above, they are rejected as the same reason set forth the rejection of claims 4-6 above.

As for independent system claim 19, which is different only from independent method claim 7 in the substitution of the "step for" for "means for", the system of NAKAO et al /ROYER ET AL includes the "means for" for carrying out the "steps for" as indicated in Figs. 1-3. Alternatively, the substitution of "means for " for "steps for" would have been obvious as mere substitution of similar or equivalent terms. Therefore, it is rejected as the same reason set forth the rejection of independent claim 7 above.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

10. The US Patent to Kobayashi discloses the endoscope usage system, and to Ohad discloses medical method and apparatus for distributed software architecture for medical diagnostic system; and the US Patent Application Publication to Henley discloses method and system for provision and acquisition of medical services and products.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thuy-Vi Nguyen whose telephone number is 571-270-1614. The examiner can normally be reached on Monday through Thursday from 8:30 A.M to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on 571-272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/T. N./

Examiner, Art Unit 3689

/Janice A. Mooneyham/

Supervisory Patent Examiner, Art Unit 3689

